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10/565,908

01/25/2006

Kimoon Kim

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03/21/2008

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WASHINGTON, DC 20005

EXAMINER

THERKORN, ERNEST G

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

03/21/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

| | | | |
|------------------------------|---------------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/565,908 | Applicant(s) KIM ET AL. | |
| | Examiner Ernest G. Therkorn | Art Unit 1797 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 and 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/4/06&10/30/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. XAD polymer is considered to be a trademark. As such, it renders the claim indefinite.

Claims 1-5 and 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 and claim 10 have different definitions of R1 and R2. As such, this inconsistency renders the claims indefinite.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065). Richter (U.S. Patent Publication No. 2004/0147396) will serve as a translation of Richter (WO 02/096553) and Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) will be considered to be a single reference. At best, the claims differ from either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in the specificity of reciting the R1 and R2 groups. Kim (European Patent No. 1,094,065) (Abstract and page 9, line 7) discloses the recited R1 and R2 groups are

suitable for packing materials of a chromatography column. It would have been obvious to use Kim (European Patent No. 1,094,065)'s R1 and R2 groups in either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) because Kim (European Patent No. 1,094,065) (Abstract and page 9, line 7) discloses the recited R1 and R2 groups are suitable for packing materials of a chromatography column.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) as applied to claims 1-5 above, and further in view of Haase (U.S. Patent No. 5,276,062). At best, the claim differs from either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) in reciting use of XAD. Haase (U.S. Patent No. 5,276,062) (column 4, lines 10-20) discloses that the Amberlite XAD series are a most preferred class of polymer for adding affinity compounds. It would have been obvious to use XAD in either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) because Haase (U.S. Patent No. 5,276,062) (column 4, lines 10-20) discloses that the Amberlite XAD series are a most preferred class of polymer for adding affinity compounds.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396)

or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) as applied to claims 1-5 above, and further in view of Snyder (Introduction to Modern Liquid Chromatography, John Wiley & Sons, Inc. New York, 1979, pages 177-183). At best, the claim differs from either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) in reciting use of a particle size range of 5-300 microns. Snyder (Introduction to Modern Liquid Chromatography, John Wiley & Sons, Inc. New York, 1979, pages 177-183) discloses that particles in the size range of 5-200 microns are right for preliminary study, preparative separation, and routine analysis. It would have been obvious to use a particle size range of 5-200 microns in either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) because Snyder (Introduction to Modern Liquid Chromatography, John Wiley & Sons, Inc. New York, 1979, pages 177-183) discloses that particles in the size range of 5-200 microns are right for preliminary study, preparative separation, and routine analysis.

Claims 1-5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) as applied to claims 1-5 above, and further in view of Duval (U.S. Patent No. 6,042,723). At best, the claims differ from either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian

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Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) in reciting the product by process limitation of being formed from a reactive polymer. Claim 9 further recites copolymerization. Kim (European Patent No. 1,094,065) (page 8, lines 45-46) discloses that cucurbitural may be used as a substitute for cyclodextrin. Duval (U.S. Patent No. 6,042,723) (column 4, lines 33-44) discloses that supports are surface modified with reactive groups to attach cyclodextrin and that use of ethylenic monomers when polymerizing cyclodextrin allows copolymerization of the cyclodextrins. It would have been obvious to form the product by the recited method in either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) because Kim (European Patent No. 1,094,065) (page 8, lines 45-46) discloses that cucurbitural may be used as a substitute for cyclodextrin and Duval (U.S. Patent No. 6,042,723) (column 4, lines 33-44) discloses that supports are surface modified with reactive groups to attach cyclodextrin. With regard to claim 9, it would have been obvious to copolymerize in either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) because Kim (European Patent No. 1,094,065) (page 8, lines 45-46) discloses that cucurbitural may be used as a substitute for cyclodextrin and Duval (U.S. Patent No. 6,042,723) (column 4, lines 33-44) discloses that use of ethylenic monomers when polymerizing cyclodextrin allows copolymerization of the cyclodextrins.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) and Duval (U.S. Patent No. 6,042,723) as applied to claims 1-5 and 9-11 above, and further in view of Haase (U.S. Patent No. 5,276,062). At best, the claim differs from either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) and Duval (U.S. Patent No. 6,042,723) in reciting use of XAD. Haase (U.S. Patent No. 5,276,062) (column 4, lines 10-20) discloses that the Amberlite XAD series are a most preferred class of polymer for adding affinity compounds. It would have been obvious to use XAD in either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) and Duval (U.S. Patent No. 6,042,723) because Haase (U.S. Patent No. 5,276,062) (column 4, lines 10-20) discloses that the Amberlite XAD series are a most preferred class of polymer for adding affinity compounds.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) and Duval (U.S. Patent No. 6,042,723) as applied to claims 1-5 above, and further in view of Snyder (Introduction to Modern Liquid Chromatography, John Wiley & Sons, Inc. New York, 1979, pages 177-183). At best, the claim differs from either

Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) and Duval (U.S. Patent No. 6,042,723) in reciting use of a particle size range of 5-300 microns. Snyder (Introduction to Modern Liquid Chromatography, John Wiley & Sons, Inc. New York, 1979, pages 177-183) discloses that particles in the size range of 5-200 microns are right for preliminary study, preparative separation, and routine analysis. It would have been obvious to use a particle size range of 5-200 microns in either Richter (WO 02/096553) in view of Richter (U.S. Patent Publication No. 2004/0147396) or Blanch (Australian Patent No. 2002302117) in view of Kim (European Patent No. 1,094,065) and Duval (U.S. Patent No. 6,042,723) because Snyder (Introduction to Modern Liquid Chromatography, John Wiley & Sons, Inc. New York, 1979, pages 177-183) discloses that particles in the size range of 5-200 microns are right for preliminary study, preparative separation, and routine analysis.

The restriction and election of species have been reconsidered, deemed proper, and made final for the reasons of record.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (571) 272-1149. The official fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ernest G. Therkorn/
Ernest G. Therkorn
Primary Examiner
Art Unit 1797

EGT
March 14, 2008